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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1943

NO. 423

SHAWKEE MANUFACTURING COMPANY,
GLENSHAW GLASS COMPANY,
McKEE GLASS COMPANY,
GEORGE R. HAUB, Petitioners,

v.

HARTFORD-EMPIRE COMPANY,
Respondent.

## BRIEF FOR RESPONDENT, HARTFORD-EMPIRE COMPANY, IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

### Official Reports of Decisions.

The decision of the court below is reported at 137 F. 2d 764 and appears at page 93 of the Record. That decision disposed not only of this case, but also of a companion case, *Hazel-Atlas Glass Company, petitioner, v. Hartford-Empire Company,* now the subject of a petition to this Court, No. 398 at this Term.

The earlier decision of the Circuit Court of Appeals, upon which was based the judgment sought to be re-

opened by the present proceeding, appears at 68 F. 2d 726. That opinion was filed January 11, 1934 and judgment was entered on the same day.

## Counter-Statement of the Case.

For convenience and brevity, petitioners will be referred to as "Shawkee", respondent as "Hartford", the petitioner at No. 398 as "Hazel", the earlier litigation against Shawkee reported at 68 F. 2d 726 as "the Shawkee infringement suit", and the earlier litigation against Hazel reported at 59 F. 2d 399 as "the Hazel infringement suit".

Although entitled below in the Shawkee infringement suit (disposed of by the Court of Appeals in 1934), the petition for certiorari seeks to bring before this Court only the proceedings on a "petition for leave to file a bill of review", filed in October 1941, but amended in January 1942 by striking out the original prayers and asking instead (1) that the Court of Appeals, on the ground of alleged fraud, set aside the judgment it had entered in the Shawkee infringement suit in 1934, vacate the final decree entered therein in the District Court, recall the mandate and restore the case to the docket of the Court of Appeals for reargument; (2) that the Court of Appeals dismiss the suit on the ground of unclean hands; and (3) that the Court of Appeals determine and assess damages "because of plaintiff's fraudulent and unlawful use of its patents", and that the damages be trebled.

Briefly stated, Shawkee's contentions are that the decision of the Court of Appeals in the Hazel in-

fringement suit was procured by fraud, in that it was induced by the Clarke article, that the decision in the Shawkee infringement suit was the result of what transpired in the Hazel infringement suit, and that the petition, although coming more than eight years after the judgment of the Court of Appeals in the Shawkee infringement suit, was based on newly-discovered evidence.

In an opinion filed June 30, 1943, the Court of Appeals—opinion by Judge JONES, Judge MARIS concurring, Judge BIGGS dissenting—denied the petition, holding:

(1) that the petition was without substance, because the Clarke article was not material to the 1932 decision in the Hazel infringement suit, or to the 1934 decision in the Shawkee infringement suit, and because

(2) representations as to the origin of the Clarke article had been made to the Court of Appeals in the Shawkee infringement suit while the same was under advisement in that court in 1933, and received the attention of all of the members of the court who had heard both cases,—"Not possibly can the information as to the facts attending the publication of the Clarke article be deemed to rate as after-discovered evidence so far as either Hazel-Atlas or Shawkee is concerned"; and

(3) that, even were the Court to conclude otherwise than against Shawkee on the merits, yet, the term in which the Court of Appeals had decided the infringement suit having long since expired, the Court of Appeals would be without power itself "to vacate or set aside the decrees of the District Court which reside

therein unaffected by any retention of jurisdiction in this court".

The court below apparently did not deem it necessary to pass upon the prayer for ascertainment and assessment of treble damages.

*Neither of the first or second grounds of the decision below is presented as a reason for granting certiorari. Each is purely* FACTUAL, *and alone is dispositive of the case.*

Since an extensive statement of fact is not essential for a disposition of the petition, we confine ourselves here to a brief recital of facts as found by the court below. In our reply to the petition at No. 398 we have set out in detail the facts pertinent to both cases, and in our appendix to this brief we set out the facts pertaining only to the instant case.

**The controlling facts found by the Court below.**

1. In the Hazel infringement suit the Peiler patent was held by the Court of Appeals (one judge dissenting) to be a pioneer patent; 59 F. 2d 399, Opinion R. p. 94 (the District Court's opinion had held the patent not infringed, but had not questioned its validity; 39 F. 2d 111). While the Clarke article was quoted and discussed in the opinion of the Court of Appeals in the Hazel infringement suit, yet, "wholly apart" from it, the majority of the court below "upon turning to *'the proofs'*,* drew their own conclusions in support of the action which the court thereupon took. * * * what was held in the Hazel-Atlas case was the court's independent judg-

* Emphasis ours throughout this brief

ment, regardless of the Clarke article" (Opinion, R. p. 101).

In the Shawkee infringement suit a limited preliminary injunction had been granted. Shawkee appealed from the order granting the preliminary injunction, and when the case reached the Court of Appeals "it was agreed the case might be disposed of as if on final hearing"; 68 F. 2d 726; this at the suggestion of counsel for Shawkee (R. p. 72).

2. While the appeal was still under advisement in the court below, counsel for Shawkee wrote to Judge BUFFINGTON, submitting certain documents to show that "the Clarke article was printed at the instigation of the Hartford-Empire Company, through one of its attorneys, R. F. Hatch" (Opinion, R. p. 99). Thereafter counsel for Shawkee communicated further with the court, stating that the matter submitted "clearly shows that the publication of this [Clarke] article in the Glass Budget was instigated by the ingenious brain of Mr. Hatch, one of the plaintiff's [Hartford's] attorneys" (Opinion, R. p. 100). "There can be no doubt that the matter received the attention of all of the members of the court which had heard the Shawkee, as well as the Hazel-Atlas case" (Opinion, R. p. 100). In brief, the matter alleged "does not qualify as after-discovered evidence in either the Hazel-Atlas or the Shawkee suit" (Opinion, R. P. 96).

3. The charge of fraud goes to the *authorship* of the Clarke article and not to its *substance*, which was not seriously challenged below. "No substantial complaint has yet been made that what the article contained in material part, namely, the ascendency of gob-feeders,

over stream feeders, was factually false" (Opinion, R. p. 101).

4. While, as stated, the Court of Appeals was advised, while the Shawkee infringement suit was under consideration, of the genesis of the Clarke article, it plainly deemed that matter to be of no moment because it held in favor of Hartford, and Judge WOOLLEY, who had dissented in the Hazel infringement suit, filed a special concurrence on the ground that he felt bound by the decision therein, a thing which he certainly would not have done had he felt that the Clarke article was a matter of consequence to the decision either in the Hazel infringement suit or in the Shawkee infringement suit (see opinion below R. p. 101).

The decision of the Court of Appeals in the Shawkee infringement suit was followed by a petition for rehearing on behalf of Shawkee, based in part on the alleged newly discovered evidence as to the Clarke article, which was denied February 21, 1934; 68 F. 2d 726. Following this, in 1935, Shawkee unsuccessfully sought leave of the Court of Appeals to file a bill in the nature of a bill of review, and in 1938 unsuccessfully sought leave in the Court of Appeals to file a petition for rehearing (Opinion, R. p. 100).

## Summary of Argument.

I

The judgment of the court below was based on three separate and distinct grounds:

First, that the Clarke article was not material to the 1934 decision of the court below;

Second, th[illegible] the evidence relied on by petitioners cannot possibly qualify as after-discovered evidence; and

Third, that, even were the Court to conclude otherwise than against Shawkee on the first two grounds, yet, the term in which the Court of Appeals had decided the infringement suit having expired, the Court of Appeals would be without power itself to vacate or set aside the decrees residing in the District Court.

Petitioners do not contend that either of the first two grounds of decision warrants review by this Court —neither is presented as a reason for granting the writ. Certiorari is therefore inappropriate. Petitioners are in reality attempting to use the third and subsidiary ground of the decision below as a lever to obtain a review of the first two grounds of that decision, which grounds were purely factual and dispositive of the case. This Court does not review controverted questions of fact on certiorari.

II

There is no conflict with the decisions of other Circuit Courts of Appeals. On the contrary, the court below followed the rule enounced by this Court and uniformly recognized, limiting the power of appellate courts

to recall their mandates. The conflict alleged by petitioners between the decision of the court below and the *Art Metal* cases in the Second Circuit is non-existent. The court below specifically considered the *Art Metal* cases and correctly differentiated this case from them. The Second Circuit Court of Appeals states and follows the general rule, also followed by the court below in the instant case, in *Nachod et al. v. Engineering & Research Corporation,* 108 F. 2d 594, decided immediately after the *Art Metal* cases. The other decisions relied on by petitioners for alleged conflict are not in point. Decisions of the same courts subsequent to those relied on by petitioners confirm respondent's contention that no conflict exists.

III

Petitioners' contention that the judgment below is in conflict with *United States v. Throckmorton,* 98 U. S. 61, and *Marshall v. Holmes,* 141 U. S. 589, is without merit. Neither of those cases is authority for the proposition that an appellate court has the power to recall its mandate after the expiration of the term, nor in conflict with the established rule that no such power exists. Those were cases dealing with original bills brought in courts of original jurisdiction. The court below specifically considered both of them and showed their inapplicability. Petitioners were not prevented from fully exhibiting their case in the infringement suit.

IV

Petitioners' contention that the decision in the Hazel infringement suit "is the machinery for effecting the fraud by which respondent has monopolized a major industry" is unsound in fact and presents no proper

ground for certiorari. The Peiler patent afforded respondent only the protection for the invention therein disclosed and claimed. The public was and is free to use the apparatus of the prior art. Moreover, petitioners are wrong in assuming that, had it not been for the Clarke article, the decisions of the Court of Appeals in the infringement cases would have been different. The court below held to the contrary. That determination constitutes no ground for the granting of certiorari, being merely a question of fact. Petitioners are not without remedy.

V

*Keystone Driller Co. v. Excavator Co.*, 290 U. S. 240, is not applicable. The doctrine of that case applies only while the court has control of the subject matter and the parties, and the decision therein in no way derogates from the rule that a Court of Appeals may not recall its mandate after the expiration of the term.

## ARGUMENT

### First Point.

**The judgment below was based on three separate and distinct grounds. Two of these grounds, either of which was sufficient fully to dispose of the case, are not presented as reasons for granting the writ; therefore, certiorari is inappropriate.**

The court below held (1):

"But, wholly apart from the Clarke article, the majority of the court in the Hazel-Atlas case, upon turning to 'the proofs', drew their own conclusions in support of the action which the court thereupon took. That such was the primary basis of the majority opinion in the Hazel-Atlas case is confirmed by the opinion for the court in the Shawkee case where, without mention of or reference to the Clarke article, this court again held the Peiler patent valid. True enough, in the Shawkee case the court referred to what it had held in the Hazel-Atlas case with respect to the validity of the Peiler patent. But that only served to confirm that what was held in the Hazel-Atlas case was the court's independent judgment, regardless of the Clarke article." (R. p. 101)

The court below further held (2):

"Not possibly can the information as to the facts attending the publication of the Clarke article be deemed to rate as after-discovered evidence so far as * * * Shawkee is concerned." (R. p. 100)

The court below then said (3):

"So far we have considered this matter on the merits of the petitioners' allegations and their

standing to seek the relief for which they petition; *and we conclude against them on both grounds.*" (R. p. 102).

The court then went on to say that, even had its conclusions in such regard been otherwise, it still lacked power to vacate the decree of the District Court, the mandate having gone down, and the term in which the judgment of the Court of Appeals was entered having long since expired.

*Petitioners do not contend that either of the first two grounds of decision warrants review by this Court—neither of them is presented as a reason for granting the writ. Certiorari is therefore inappropriate:*

"It is well settled that this Court confines itself to the ground upon which the writ was asked or granted, the review here being no broader than that sought by the petitioner. Clark v. Williard, 294 U.S. 211, 216; Helvering v. Tex-Penn Oil Co., 300 U.S. 481, 498; Washington V. and M. Coach Co. v. National Labor Relations Board, 301 U.S. 142, 146." *Helis v. Ward,* 308 U.S. 365, 370.

"This Court confines itself to the ground upon which the writ was asked or granted. Alice State Bank v. Houston Pasture Co., 247 U.S. 240, 242. Clark v. Williard, 294 U.S. 211, 216." *Morehead v. New York ex rel. Tipaldo,* 298 U.S. 587, 604-5.

"But as that is not the ground upon which the writ of certiorari was asked or granted, we confine our discussion to the matter relied upon in asking the intervention of this Court. Hubbard v. Tod, 171 U.S. 474, 494." *Alice State Bank et al. v. Houston Pasture Co.,* 247 U.S. 240, 242.

Accordingly, should this Court grant the writ and decide "the ground upon which the writ was asked" favorably to Shawkee, the judgment below would still stand because its first two grounds of decision—or either of them—fully disposed of the controversy. Certiorari is consistently denied in such cases, or, if granted under misapprehension, is promptly revoked:

> "The decision of this case does not require a decision of the questions which are presented in the petition for certiorari *because of which the writ was granted*, and the certiorari heretofore granted in this case is therefore revoked upon the authority of Southern Power Co. v. North Carolina Service Co., 263 U.S. 508." *United States v. McFarland*, 275 U.S. 485.

In *Keller v. Adams-Campbell Co.*, 264 U. S. 314, this Court granted certiorari in a patent infringement suit to review the question of scope of intervening rights—a question sufficiently important to justify the granting of the writ. On the hearing, it developed that although the lower courts had passed upon the question of intervening rights, they had also decided the question of infringement, which alone was sufficient to dispose of the case. In these circumstances, this Court said:

> "The result is that an order must be entered dismissing the writ of certiorari as improvidently granted * * *." (264 U.S. at 320)

Petitioners are in reality attempting to use the third, and subsidiary, ground of the decision below as a lever to obtain a review of the first two grounds of that decision, which grounds were purely factual and each of which was fully dispositive of the case. But this Court

does not review on certiorari controverted questions of fact:

"This writ must be dismissed * * *.

"The argument developed that the controverted question was whether the evidence sufficed to establish actual dedication of petitioner's property to public use—*primarily a question of fact.* That is not the ground upon which we granted the petition and if sufficiently developed would not have moved us thereto." *Southern Power Co. v. North Carolina Public Service Co.*, 263 U.S. 508, 509.

"Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it." *General Talking Pictures Corp. v. Western Electric Co.*, 304 U.S. 175, 178.

"We do not grant a certiorari to review evidence and discuss specific facts." *United States v. Johnston*, 268 U.S. 220, 227.

As this Court said in *Magnum Co. v. Coty*, 262 U.S. 159, 163:

"The jurisdiction to bring up cases by certiorari * * * was not conferred upon this Court merely to give the defeated party in the Circuit Court of Appeals another hearing."

**Second Point.**

**The judgment below is not in conflict with the decisions of other Circuit Courts of Appeals.**

The court below, after disposing of the case on the merits, held that it lacked power to recall its mandate, or to vacate the District Court's decree entered pursuant thereto, after the expiry of the term in which the mandate had issued and the judgment had been entered. The court below (R. p. 102), far from creating a conflict with the Second Circuit Court of Appeals, as contended by petitioners (Petition, p. 13), adhered to the general rule, following and quoting from the same court's decision in *Nachod et al. v. Engineering & Research Corporation*, 108 F. 2d 594:

> " 'Our term having expired since the mandate went down, we have no power to recall it.' (citing cases)".

Thus both Courts of Appeals reiterate and follow the fundamental principle enounced by this Court in *Bronson v. Schulten*, 104 U. S. 410, 415; and uniformly observed by the Circuit Courts of Appeals, *e.g.*:

FIRST CIRCUIT:

*Casey v. Sterling Cider Co.*, 15 F. 2d 52;
*Hart et al. v. Wiltsee et al.*, 25 F. 2d 863.

SECOND CIRCUIT:

*Watts, Watts & Co., Limited, v. Unione Austriaca Di Navigazione*, 239 Fed. 1023;
*Sundh Electric Co. v. Cutler-Hammer Mfg. Co.*, 244 Fed. 163, 170;
*Dobson v. United States*, 31 F. 2d 288; certiorari denied 278 U. S. 653.

THIRD CIRCUIT:

*Montgomery v. Realty Acceptance Corp.*, 51 F. 2d 642; affirmed 284 U. S. 547.

FOURTH CIRCUIT:

*Foster Bros. Mfg. Co. Inc. v. National Labor Relations Board*, 90 F. 2d 948.

SEVENTH CIRCUIT:

*Hawkins v. Cleveland, C., C. & St. L. Ry. Co.*, 99 Fed. 322.

EIGHTH CIRCUIT:

*Guaranty Trust Co. of New York et al. v. Minneapolis & St. L. R. Co. et al.*, 98 F. 2d 345, 346-7;

*Reynolds et al. v. Manhattan Trust Co. et al.*, 109 Fed. 97, 98-99.

Petitioners contend (Petition, pp. 13-14) that the decision of the court below is in conflict with the decisions of the Circuit Court of Appeals for the Second Circuit, antecedent to the *Nachod* case above cited, in *Art Metal Works, Inc., v. Abraham & Straus, Inc.*, 107 F. 2d 940, 107 F. 2d 944, certiorari denied 308 U. S. 621. The *Art Metal* cases, however, are not germane because based on a wholly different state of facts. The court below specifically considered the *Art Metal* cases and correctly differentiated this case from them.

In the *Art Metal* cases the defendant had bribed Judge MANTON, who had written the opinions in both of the cases. The decision in one of them, reversing the District Court, was by a divided "court".* Upon application to the Circuit Court of Appeals, it recalled its "mandate", set aside the "judgments" entered pursuant

* 70 F. 2d 639; 70 F. 2d 641.

thereto, and restored the cause to its docket for "re"-argument of the appeals. But this action in no way diminished the force of the rule of the *Nachod* case, *supra,* as the court below pointed out:

> "The procedure followed in the Art Metal cases, cited *supra,* does not derogate from this rule. There the vote of a judge of the Court of Appeals who had been corrupted in respect of that litigation was necessary to produce one of the two decisions in the appellate court between the same parties and involving the same patent, so that *no qualified court had really disposed of those appeals;* and, by the same token, *no competent mandates ever issued, hence, the term time was irrelevant:* The appeals were in effect treated as never having been *coram judice* theretofore. The orders thereupon entered in order to clear the record in the Art Metal cases of the former invalid action taken therein cannot properly be utilized to spell out power in a Circuit Court of Appeals to recall its mandate after the expiration of the term when no action has been taken within the term to continue the jurisdiction of the court. The view we thus take of the procedure followed in the Art Metal cases is confirmed by the fact that after the action taken therein looking to a *de novo* argument of those appeals, the same court, composed of the same judges who had sat for the reargument of the Art Metals appeals and had disposed of them on November 20, 1939, just one month later (December 22, 1939) reasserted in the Nachod case, *supra,* the lack of power in a Court of Appeals to recall its mandate after the term has expired." (Opinion, R. pp. 102-103).

Examination of the proceedings in the Second Cir-

cuit Court of Appeals reveals that counsel for Art Metal, in seeking relief from the "judgments" which its adversary had bought and paid for, gave full recognition to the legal principle relied upon by the court below in the instant case, but differentiated from it, stating in their brief before the Circuit Court of Appeals that in the *Art Metal* cases:

> "No decree, therefore, was rendered by a duly constituted and completely disinterested court, and, in legal effect, no hearing was had by the plaintiff. The decrees, therefore, are void and a nullity."

The distinction between the power to set aside, after term, a void "judgment" and the lack of power to set aside, after term, a genuine final judgment by a properly constituted court is basic and has been carefully observed by the Circuit Court of Appeals for the Second Circuit itself. Thus, although that court in the *Art Metal* cases exercised the power to vacate void "judgments" after the close of the term in which they were "entered", it recognized in immediately subsequent decisions that it had no power to vacate after term the judgment entered by a genuine court; *Beidler v. Photostat Corporation,** certiorari denied 310 U. S. 648; *Nachod v. Engineering & Research Corporation, supra.*

If follows that there is no conflict between the *Art Metal* cases and the case at bar.

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* Here agents of Manton had unsuccessfully attempted to induce the petitioner to pay substantial sums to buy a favorable decision, informing the petitioner that unless a satisfactory arrangement was made, the case would be decided adversely to him. The Circuit Court of Appeals for the Second Circuit refused to recall its mandate and vacate its judgment after the close of the term in which it had been entered, and this Court denied certiorari.

Petitioners further contend that the decision below is in conflict with *Winslow v. Staab*, 242 Fed. 426 (C.C.A. 2), *United States v. Sterling*, 70 F. 2d 708 (C.C.A. 2), certiorari denied, *Commercial Trust Co. v. United States*, 293 U. S. 584, *In Re New England Oil-Refining Co.*, 9 F. 2d 344 (C.C.A. 1), and *United States ex rel. Fisher v. Williams*, 67 Fed. 384 (C.C.A. 8).

No conflict exists.

In *Winslow v. Staab* the Circuit Court of Appeals for the Second Circuit affirmed the action of the *District Court* in setting aside a decree upon the ground of an innocent misrepresentation by counsel, at that counsel's request.

In *United States v. Sterling*, the Circuit Court of Appeals for the Second Circuit affirmed the action of the *District* Court in setting aside a judgment of dismissal for want of prosecution on the ground that the Clerk had erroneously placed the case on the call calendar when in fact the case had been referred to a special master.

In *The New England Oil-Refining Company* case, the Circuit Court of Appeals for the First Circuit denied a petition for a writ of mandamus requiring the *District* Court to allow an appeal from its own order on the ground that petitioner's rights had not been impaired. The *District* Court had apparently set aside on its own motion a prior order approving a plan of reorganization on the ground of fraudulent representations, during the course of receivership proceedings *which had not yet terminated.*

In *United States ex rel. Fisher v. Williams*, the Circuit Court of Appeals for the Eighth Circuit approved

the action of the *District* Court in setting aside a final decree which the District Judge had not read and which had been represented by counsel who prepared it as being interlocutory.

None of these cases is authority for the proposition that a Circuit Court of Appeals has the power to recall its mandate after the expiration of the term of its entry.

Moreover, in each of the Circuits in which the cases relied on were decided, there have been subsequent decisions confirming the lack of such power.

We have already referred to the decisions of the Second Circuit Court of Appeals in the *Nachod* and *Beidler* cases.

In the First Circuit see *Casey v. Sterling Cider Co.*, 15 F. 2d 52 where the court said:

> "As the term at which the order of December 21, 1923, was entered has long since expired, and the modification desired would involve a matter of substance, and not of mere form, we are without power to make the modification, and the motion must be denied."

See also *Hart v. Wiltsee*, 25 F. 2d 863, where, on a motion to recall the mandate after the expiration of the term of its entry, the same court said:

> "* * * after the close of the term at which a final decree has been entered, it cannot be modified in any matter of substance, but only for clerical errors."

In the Eighth Circuit see *Guaranty Trust Co. v. Minneapolis & St. L. R. Co.*, 98 F. 2d 345, 346-7, where the court said:

"This Court, of course, retains not one vestige of jurisdiction to modify or to empower the court below to modify this decree, since the term at which the mandate of this Court was entered has long since expired."

**Third Point.**

**The judgment below is not in conflict with the decisions of this Court.**

Petitioners contend (Petition pp. 18-19) that the judgment below is in conflict with *United States v. Throckmorton,* 98 U. S. 61, and *Marshall v. Holmes,* 141 U. S. 589. No conflict exists. Neither of those cases is authority for the proposition that an appellate court has the power to recall its mandate after the expiration of the term in which its judgment was entered and its mandate issued, even upon the ground of fraud. In both those cases original bills to obtain relief from judgments allegedly obtained by fraud were brought in courts of *original* jurisdiction. The court below in the case at bar specifically considered both cases and pointed out (Opinion R. pp. 103-4) that if Shawkee feels itself aggrieved, the course is open to it to file an original bill to impeach the decree now standing against it in the District Court.

As pointed out by the court below (Opinion R. p. 104), it is only in the situation where an original bill has been filed in a court of original jurisdiction that the rule of those cases "as to whether the alleged fraud is extrinsic or intrinsic, becomes germane".

Petitioners contend that they were prevented "from fully exhibiting their case" (petitioners' brief, p. 19)

and in the same sentence admit that the prior art that they rely on was thoroughly presented at the trial! Petitioners have not pointed to any evidence relating to any issue in the infringement suit which they were "prevented from exhibiting".

The question as to what kind or degree of fraud will justify relief against a judgment allegedly obtained thereby is not germane to the ground of the judgment below upon which certiorari is sought, i.e., the lack of power of the court below to recall its mandate after the expiry of the term of its entry.

The court below in holding that the alleged fraud was not material to its 1934 judgment found it unnecessary to distinguish between "intrinsic" and "extrinsic" fraud or to discuss the alleged conflict between the *Throckmorton* case and *Marshall v. Holmes,* but relied on *Toledo Scale Co. v. Computing Scale Co.,* 261 U. S. 399, 421, where this Court said:

> "There has been much discussion as to whether extrinsic fraud is here alleged, and the case of United States v. Throckmorton, 98 U.S. 61, is cited and numerous other authorities since that case. We do not find ourselves obliged to enter upon a consideration of the sometimes nice distinctions made between intrinsic and extrinsic frauds in the application of the rule, *because in any case to justify setting aside a decree for fraud whether extrinsic or intrinsic, it must appear that the fraud charged really prevented the party complaining from making a full and fair defense. If it does not so appear, then proof of the ultimate fact, to wit, that the decree was obtained by fraud, fails.*"

Clearly, there is no conflict between the judgment below and either *United States v. Throckmorton* or *Marshall v. Holmes.*

**Fourth Point.**

**Petitioners' contention, that the decision in the Hazel infringement suit "is the machinery for effecting the fraud by which respondent has monopolized a major industry", is unsound in fact and presents no proper ground for certiorari.**

The Peiler patent afforded respondent only the protection of the particular invention therein disclosed and claimed. The public was and is free to use the apparatus of the prior art. Petitioners were not satisfied to use that apparatus but insisted upon using the Peiler invention, as both the District Court and the Circuit Court of Appeals found.

Petitioners assume that, had it not been for the Clarke article, the decisions of the Court of Appeals in the infringement cases would have been different. But the court below in the instant case held to the contrary. That determination is not presented as a ground for review, and if it were it would not warrant the writ, for as we pointed out under our First Point, *supra,* (pp. 11-12) this Court does not review controverted questions of fact.

The effect of the judgment below is the same as if the court had considered the petition as one for leave to file a bill of review in the District Court and had denied that leave on the merits, first, because petitioners' laches and lack of diligence prevented their showing to that

court from qualifying as after-discovered evidence, and second because the facts they belatedly presented were immaterial.

Moreover, the court below pointed out (Opinion, R. pp. 103-4) that it is still open to petitioners to file an original bill in a court of original jurisdiction to impeach the judgment in the infringement case on the ground of alleged fraud, citing *Dowagiac Mfg. Co. v. McSherry Mfg. Co.*, 155 Fed. 524, 527, 528; Cyclopedia of Federal Procedure, Vol. 4, Sec. 1159, pp. 342-345. See also *Realty Acceptance Corporation v. Montgomery*, 6 F. Supp. 593; affirmed 77 F. 2d 762 (C.C.A. 3), certiorari denied 296 U. S. 590, rehearing denied 296 U. S. 662.

**Fifth Point.**

**There is no conflict between the judgment below and the Keystone Driller case.**

Petitioners assert that the judgment below is in conflict with this Court's decision in *Keystone Driller Co. v. General Excavator Co.*, 290 U. S. 240. But the doctrine of unclean hands applies only while the court has control of the subject matter and the parties; *United States v. Morgan*, 307 U. S. 183, 197. The *Keystone Driller* case in no way derogates from the rule that a Circuit Court of Appeals may not recall its mandate after the expiration of the term of its entry. There is thus no conflict and no ground for certiorari.

**Conclusion.**

Petitioners are in reality belatedly seeking reconsideration of issues heretofore fully litigated. This is their *tenth* application to this Court or to the Third Circuit Court of Appeals since its original decision.

The Clarke article as published was entirely true. Petitioners have not pointed to any evidence relating to the issues of the infringement suit which they were deprived of exhibiting below.

Petitioners have had their day in court with respect to the issues of validity and infringement of the patent and those issues were determined against them. Now petitioners have had a hearing as to the effect of the authorship of the Clarke article, and as to petitioners' standing to present to a court their unsubstantiated claim of recently acquired knowledge thereof, and both issues—neither of which would present a proper question for review by this Court—were determined against them. We respectfully submit that petitioners have no standing to seek a further review by this Court.

**The petition should be denied.**

Respectfully submitted,

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## APPENDIX

**The Clarke Article.**

The Clarke article was prepared in the first instance under the circumstances related in the Appendix to Hartford's brief in opposition to the petition of Hazel in No. 398 and Hartford refers to and adopts the same as a part hereof to show the facts and circumstances as to the preparation of said article, the use thereof before the Circuit Court of Appeals in the Hazel infringement suit, the reply made thereto by Hazel in its original appeal brief in that suit and the truth of the facts set out in said article.

**The Proceedings in the Shawkee Infringement Suit.**

The bill of complaint was filed May 31, 1933. At that time, one of the defendants, Shawkee Manufacturing Company, was making and offering for sale glass feeders whose operation was charged to infringe the Peiler patent in suit. Two other defendants, Glenshaw Glass Company and McKee Glass Company, were using the like feeders in day to day operation. The fourth defendant, George R. Haub, was an engineer formerly in the employ of Hartford and of Hazel, and was the designer of the accused feeders (R. p. 71).

The District Court filed its opinion on July 22, 1933, granting a preliminary injunction, limited, however, to enjoining the sale or disposition of the accused feeders to third parties, and refusing to enjoin the use of the feeders by the defendants themselves (R. p. 72).

On June 27, 1933, the defendants filed their joint answer. Two of the defendants, Glenshaw Glass Company and McKee Glass Company, admitted in the answer that they were then and had been licensed by Hartford to use certain glass feeders owned by Hartford and embodying and performing inventions of Hartford, including "the method invention of the letters patent here in suit; and that they have acknowledged and recognized and still continue to acknowledge and recognize the validity of letters patent of plaintiff including the letters patent here in suit". The defendants averred, however, that if the claims in suit of the Peiler patent 1,655,391 in suit were interpreted to include the apparatus and method of the accused device, then they were invalid in view of certain prior art cited, including prior art not before the court in the Hazel infringement suit (R. pp. 71-72).

The Shawkee defendants appealed to the Third Circuit Court of Appeals. The appeal was argued on October 3, 1933. During the hearing of the appeal, Shawkee's counsel proposed in open court that the parties stipulate that the case be considered by the Court of Appeals as if on final hearing, and a written stipulation to that effect was entered into and filed forthwith (R. p. 72).

On October 20, 1933, one of the counsel for Shawkee wrote to one of the counsel for Hartford (R. p. 76), stating that, after the argument in the Circuit Court of Appeals, certain correspondence had been brought to the attention of Shawkee's counsel "showing that the (Clarke) article * * * was published * * * at the request of Hartford-Empire Company by one of its attorneys, Mr. R. F. Hatch * * *," and on October 30th said counsel for Shawkee advised the Judges of the

Court of Appeals of the correspondence just referred to (R. p. 80). On the same day, counsel for Hartford advised counsel for Shawkee that if the latter desired that the correspondence "be placed before the Circuit Court of Appeals and that Court is willing to accept it, we will interpose no objection" (R. p. 79).

Further correspondence relating to the Clarke article ensued between counsel for Shawkee and counsel for Hartford, and between them and the Judges of the Court of Appeals.

Two of the letters submitted to the Judges of the Court of Appeals are especially significant. One is a letter written by Edmund P. Wood, Esq., to the late William J. Belknap, Esq., on November 14, 1933 (Record at No. 398, p. 116)* (copies of which were furnished to the Judges of the Court of Appeals and to Shawkee's counsel), confirming the fact that Mr. Wood was aware, prior to the trial of the Hazel infringement suit, that R. F. Hatch of Hartford had been instrumental in having the Clarke article published. The other is a letter written by counsel for Shawkee to the Judges of the Court of Appeals on December 16, 1933, calling attention to the then recent decision of the Supreme Court in *Keystone Driller Co. v. General Excavator Co.*, 290 U. S. 240, and asserting that the facts as to the genesis of the Clarke article constituted a case of unclean hands, and further stating that the correspondence sent to the Court of Appeals showed that

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*In the proceedings below, the Hazel and Shawkee cases were argued and decided together, and Hartford, by reference, made the pertinent parts of its reply in the Hazel case a part of its reply here (R. p. 64).

> "the publication of this article in the Glass Budget was instigated by the ingenious brain of Mr. Hatch, one of plaintiff's attorneys",

was used in the Patent Office and that later, plaintiff's brief in the Hazel infringement suit in that court "quoted from this article" (Record at No. 398, p. 105).

On January 11, 1934, the opinion of the Circuit Court of Appeals was filed, dismissing the appeal (68 F. 2d 726), and judgment was entered the same day. On February 8, 1934, a petition for rehearing was filed, based in part on the alleged newly discovered evidence as to the Clarke article, and again alleging that it showed Hartford was in court with unclean hands. On February 21, 1934, the petition was denied.

On April 3, 1934, Shawkee filed a petition in this Court for a writ of certiorari, No. 922, October Term, 1933, accompanied by a brief in which reference was made (page 23) to "publications upon which the [Circuit] Court [of Appeals] relies * * *". These "publications" included the Clarke article which, however, was not mentioned by name. This petition was denied May 7, 1934, 292 U. S. 640.

Thereafter, Shawkee made numerous applications to the Circuit Court of Appeals and filed two additional petitions to this Court for writs of certiorari, seeking to reopen the infringement suit, all of which were denied. The second petition for certiorari was denied October 15, 1934, 293 U. S. 600; and the third petition for certiorari was denied October 28, 1935, 296 U. S. 635.

None of Shawkee's many applications to the Circuit Court of Appeals and to this Court, after its first petition for certiorari in April, 1934, made any reference to the Clarke article.

Meanwhile, an accounting of profits and damages proceeded, pursuant to the mandate of the Circuit Court of Appeals, until, in February, 1939, the parties settled the accounting by agreement, and *a final decree was entered by the District Court* (R. p. 17).

On October 24, 1941, the original petition herein was filed. It was Shawkee's *ninth* application to the Circuit Court of Appeals or to this Court since the Court of Appeals originally decided the case. The present petition is the tenth attempt.

**Shawkee's Inactivity from 1934 to 1941.**

Counsel for Shawkee was advised by counsel for Hartford by a letter dated October 24, 1933 (R. p. 77) that the existence of the papers presented to the Judges of this Court by counsel for Shawkee, as aforesaid, were known to counsel for Hazel before its appeal was heard by the Circuit Court of Appeals, and by letter dated October 30, 1933 (R. p. 80) counsel for Shawkee was advised that the same was also known to counsel for the defendant in the *Nivison-Weiskopf* case (Messrs. Wood and Wood). Hartford refers to the Appendix to its brief in No. 398, pages 26, 27 and 28, for a statement of the facts as to the knowledge of counsel for Hazel-Atlas and Nivison-Weiskopf on this matter as of October 30, 1933.

By said letters of October 24 and October 30, 1933, counsel for Shawkee were given such information that by the exercise of only ordinary diligence, they could have ascertained all the additional facts as to the authorship of the article had they chosen to do so.

Counsel for Shawkee thereafter wrote to counsel for Hazel (Record at No. 398, p. 104) asking whether he could confirm the information given to counsel for Shawkee by counsel for Hartford "that the matters relating to the article in the Glass Budget" referred to in the papers submitted by counsel for Shawkee to the Court on October 30, 1933, as above stated, "were fully known to counsel" for Hazel at the time the case was tried. He received a reply (R. p. 70) stating that counsel for Hazel had the impression that he had believed, prior to the trial of the Hazel infringement suit, that a Hartford representative was responsible for the Clarke article, but that he would have to go through his records before he could answer more definitely.

It nowhere appears that Shawkee's counsel made any effort to have counsel for Hazel make any examination of his records to refresh his recollection as to what he knew about the article, or that they made any effort to ascertain what knowledge Messrs. Wood and Wood had after a copy of Mr. Edmund Wood's letter to Mr. Belknap was sent to counsel for Shawkee, as aforesaid.

As hereinbefore stated, Shawkee's counsel proposed in open court at the hearing of its appeal in the Shawkee infringement suit that the parties stipulate that the case be considered by the Court of Appeals as if on final hearing, and such a stipulation was made. Although Shawkee wrote to the Judges of the Court of Appeals, prior to the decision of that court, "that the publication of this article in the Glass Budget was instigated by the ingenious brain of Mr. Hatch, one of plaintiff's attorneys * * *" (R. p. 72), no request was made that the defendants be relieved of the stipulation which their counsel had proposed, providing for the disposition of the

case as though on final hearing, and no request was made that the case be reopened to receive evidence as to the genesis or truth of the Clarke article. In the petition for rehearing above referred to, no contention was made that said stipulation had been entered into inadvertently nor did Shawkee seek to be discharged therefrom.

On December 11, 1939, the United States of America filed a complaint in the United States District Court for the Northern District of Ohio, Western Division, against Hartford, Hazel and ten other corporate defendants and a large number of individuals, alleging violation of the anti-trust laws of the United States. The complaint in that anti-trust suit contained detailed charges as to the authorship of said article (R. p. 69; Record at No. 398, p. 187, pp. 205-6) which were thereby made of public record. A complete copy of said complaint was in the hands of present counsel for Shawkee shortly after the filing thereof, as was admitted by said counsel at the hearing in the Circuit Court of Appeals on the original petition. There is nothing to show that Shawkee made any attempt to investigate the facts as to the preparation of said article in or immediately after December, 1939 when Shawkee's counsel came into possession of the said complaint, or to call the same to the attention of the Circuit Court of Appeals at that time.

**Petitioners' Reason for Resuming Activity in 1941.**

Glenshaw Glass Company, one of the Shawkee petitioners herein, was a licensee of Hartford before, during and after the Shawkee infringement suit, paying agreed royalties for its use of certain machinery owned by Hartford (R. p. 71).

In 1940, Glenshaw, being still such a Hartford licensee, refused to continue payment of the agreed royalties, and on October 14, 1941, Hartford sued Glenshaw for the overdue royalties.

On October 24, 1941, the original Shawkee petition herein was filed in the Circuit Court of Appeals.

**Factual errors in the petition.**

The instant Shawkee petition and brief include important factual errors, including the following:

(1) The petition and brief repeatedly allege (pages 4, 5, 9, 10, 12, 19) that the Clarke article is factually false. These charges are contrary to the record and contrary to the findings of the court below (Opinion, R. p. 101). No such charge is made in the petition or brief in the companion Hazel case, No. 398.

The only items of evidence cited (Petition pp. 5-6) for petitioners' charges of falsity in the Clarke article are letters concerning Hatch's first draft of the article and the correction thereof, together with a letter by Mr. Carter of the Owens company approving the article "if not too rank", i. e., if "not too rough on Owens" (Record at No. 398, p. 92).

The record plainly shows that, although Hatch's first draft of the article did contain some errors, those errors were corrected (Record at No. 398, pp. 84-87), and *the article, as published, was and is entirely true.* The truth of the article is established beyond question by the Clarke affidavit of 1932 (Record at No. 398, p. 111), by the Maloney affidavit of 1935 (Record at No. 398, p. 112), and by affidavits of Dorsey, Hatch and Brown (Record at No. 398, pp. 113, 80, and 73).

(2) The Shawkee petition erroneously states (pp. 4-5) that the publication of the Clarke article was suggested by R. D. Brown of Hartford to H. W. Carter of the Owens company. The record clearly shows that there was no connection whatever between Brown's suggestion to Carter that Carter write an historical article and Hatch's later preparation of the Clarke article. See Record at No. 398, p. 75 (Brown affidavit); and also p. 83, p. 87 (Hatch affidavit) which show that when Hatch drafted the article, he did not know that it was to be filed in Patent Office proceedings, did not compile it for that purpose, "but solely in order to bring the facts stated in the article to the attention of the glass making trade", and did not make any changes in the article in view of its presentation to the Patent Office.

(3) The Shawkee petition further erroneously states (p. 6) that the references to the Clark article in Hartford's brief before the Court of Appeals in the Hazel infringement suit "were known to be false when they were made to the court by respondent". On the contrary, the record shows that those references were entirely true when they were made. See the evidence cited above at page 32, showing that the Clarke article *as published* was true throughout.

Notwithstanding the harsh words used in the Shawkee petition and brief, such as "false", "corrupt", "spurious", etc., the facts remain that the Clarke article was factually true; that it was checked and corrected by Clarke and by him verified through consultation with Maloney, another union official familiar with the facts; and that it was thereupon adopted by Clarke as his own, all prior to its publication (Record at No. 398, pp. 85-86).

The Appendix to Hartford's brief in opposition to the Hazel petition, No. 398, points out at pages 33-36, certain factual errors of importance in the dissenting opinion below. Hartford refers to and adopts that portion of said Appendix, as the errors therein referred to are pertinent to the Shawkee case as well as to the Hazel case.